

REMARKS/ARGUMENTS

Claims 1-3 are pending in the present application. Claims 4-10 have been added. The drawings have been objected to for several informalities. Claims 1-3 have been rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, more specifically, for a lack of antecedent basis in claim 1. Claim 1 has been amended to overcome this antecedent problem and is now considered in allowable form. Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Le Grand (U.S. Patent No. 1,196,252). Claim 2 has been rejected under U.S.C. § 103(a) as being unpatentable over Le Grand in view of Coulter (U.S. Patent No. 6,564,681). Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Geier, Jr. (U.S. Patent No. 3,318,176). Applicant respectfully traverses all rejections.

The drawings have been objected to because of some additional vertical lines were added that the Examiner was unclear as to what the lines represented. The Applicant has amended the drawings submitted in red and additionally has submitted a replacement sheet to remove these vertical lines. Additionally, the drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because they did not include the reference sign mentioned in the description item 24. The drawings have been amended to include numeral 24 that replaces numeral 50 and the specification has been amended to eliminate numeral 50 by replacing 50 with numeral 24. Consequently, all drawings objections are overcome.

Claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Le Grand. Anticipation "requires that the same

invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Amended claim 1 in part requires "a third storage compartment disposed within the body for receiving a plurality of punches." As admitted by the Examiner "Le Grand discloses the invention but fails to disclose a storage compartment is provided in the handle (body) for receiving a plurality of punches." (Office Action page 5). Thus, each and every limitation of the claimed invention is not present in the Le Grand reference and therefore the anticipation rejection must be

withdrawn. Additionally, because this limitation of claim 2 has been written into claim 1, claim 2 has been cancelled.

Claim 2, that has been written into claim 1, was rejected under U.S.C. § 103(a) as being unpatentable over Le Grand in view of Coulter. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion

or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

The obvious rejection asserted by the Examiner is based on a combination of prior art references, e.g., the punch holder having a storage compartment of Couleter combined with the punch holder of Le Grand. To justify this combination the Examiner states "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention, to have provided Le Grand

with a storage compartment in the handle, as taught by Coulter for added convenience so the user can have all the necessary tools at his disposal." (Office action page 5). Rather than point to specific information in Coulter that suggests the combination with the punch holder of Le Grand, the Examiner described the general functions of the storage compartment. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts or findings that might serve to support a proper obviousness analysis. See, e.g., Pro-Mold & Tool, 75 F.3d 1568, 1573, 37 USPQ2d. 1626, 1630 (Fed. Cir. 1996).

To the contrary, the Examiner's decision is based on a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. (Office action page 5). Yet this reference by reference limitation by limitation analysis fails to demonstrate how the Coulter reference teaches or suggests its combination with Le Grand to yield the claimed invention.

Even if there is a suggestion or motivation to combine, the apparatus that would result still would not meet the limitations of the amended claim 1. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the

patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 in part requires "a third storage compartment disposed within the body for receiving a plurality of punches." The Le Grand device provides for a first compartment 10 wherein the spring 19 is located and a second compartment wherein the tool 20 may be held by the ribs 15 and 16. The Le Grand reference, however, does not teach for a third compartment that allows for storage. Similarly, the Coulter reference teaches a first compartment wherein the nail is held and a second compartment that holds nails. However, the Coulter reference does not teach the use of a third compartment. The significance of the third compartment in the Applicant's disclosure is that by breaking the punch holder into three separate compartments, the Applicant is able to separate the storage space from the spring biased punch holder which provides an advantage over both Le Grand and the Coulter references. Thus, neither Le Grand nor Coulter teach a third storage compartment disposed within the body as is required by the claims and consequently the obviousness rejection must be withdrawn. Additionally, claim 4 depends on claim 1 and therefore is also considered in allowable form.

New claim 5 adds the limitation "a threaded plug engaging the spring to adjust the compression of the spring." None of the references cited against the Applicant, Le Grand, Coulter nor Geier teach a threaded plug that engages a spring element that adjusts the compression of the spring. Thus, the Applicant's disclosure teaches an advantage over the prior art in that when the Applicant's spring becomes worn the threaded plug may be used to adjust the compression of the spring to ensure that the punch will be properly held by the device.

Because the prior art does not teach each and every limitation of new claim 5 this claim is considered in allowable form. Additionally, claims 6 and 7 depend on claim 5 and for at least this reason are considered in allowable form.

New claim 8 writes dependent claim 3 into the original claim 1. Thus claim 3 has been cancelled. Claim 3 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Geier. The obviousness rejection asserted by the Examiner is again based on a combination of prior art references, e.g., the wrench having a pentagonal socket combined with the punch holder of Le Grand. To justify this combination the Examiner states "[i]t would have been obvious of one of ordinary skill in the art at the time of the invention to have provided Le Grand with frusto-shaped enclosed compartment, as taught by Geier, Jr. to allow the tool to conform to the old and well known shape of most shanks." (Office action page 5). Rather than pointing to specific information in Geier to suggest the combination with the punch holder of Le Grand, the Examiner described the general functions of the Geier socket. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts or findings that might serve to support a proper obviousness analysis.

To the contrary, the Examiner's decision is based on a discussion of ways that the multiple prior art references can be combined to read on the claimed invention. (Office action page 5). Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Geier reference teaches or suggests its combination with Le Grand to yield the claimed

invention. For example, the Examiner has not explained why one of ordinary skill in the art would combine the pentagonal socket in Geier with the Le Grand reference to create the Applicant's invention when the Applicant requires a frusto-shaped first compartment having a flat head. The Geier reference shows a hexagonal shaped socket that has a pointed head that is unlike the Applicant's flat frusto-shaped compartment. Thus, when Geier, a person of ordinary skill in the art, chose to hold a tool with a plunger device, he chose not to use a frusto-shaped compartment but rather chose to use pentagonal shaped socket. (Col. 3, lines 4-10). In this respect, Geier teaches away from the proposed combination. This is a point that the Examiner did not address in the office action.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path the Applicant took. In re Gurley, 27 F.3d 551, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Here, because Geier teaches the use of a pentagonal socket to hold a tool, one skilled in the art upon reading Geier would have been led on a path divergent from that taken by the Applicant.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to combine the prior art references, in addition to the disclosure of Geier which teaches away from the proposed combination, the Examiner's conclusion of obviousness, as a matter of law, cannot stand.

Even if there was suggestion or motivation to combine, the apparatus that would result still would not meet the limitations

of claim 8. More specifically, the proposed combination would not include a first compartment that "is frusto-shaped having a flat head and tapered side walls." The Geier patent teaches a pentagonal socket that provides for a plunger 28 that pushes a tool 34 against two tapered side walls that come to a point. This pentagonal compartment has side walls that are tapered to a point and not a flat head, and thus, is not frusto-shaped as is required by the claim. Additionally, the Le Grand reference provides for rib portions 15 and 16 that are arcuate and thus, additionally, are not frusto-shaped. (Col. 2, lines 55-56). Thus, the prior art references do not teach a frusto-shaped first compartment as is required by new independent claim 8 and therefore and obviousness rejection cannot stand. Additionally, new claims 9 and 10 depend on claim 8 and for at least this reason are considered in allowable form.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley
Reg. No. 45,253
ZARLEY LAW FIRM, P.L.C.
Capital Square

Application No. 10/786,687
Docket No. P06555US1
Reply to Office Action of November 3, 2004

400 Locust Street, Suite 200
Des Moines, IA 50309-2350
Phone No. (515) 558-0200
Fax No. (515) 558-7790
Customer No. 34082
Attorneys of Record

- JLH/bjs -

Application No. 10/786,687
Docket No. P06555US1
Reply to Office Action of November 3, 2004

Amendment to the Drawings:

The attached sheet of drawings includes changes to Figs. 2 and 3. This sheet, which includes Figs. 2, 3, replaces the original sheet including Figs. 2-3. In Fig. 2, previously vertical lines have been eliminated. In Fig. 3 numeral 50 has been replaced with numeral 24.

Attachment: Replacement Sheet
 Annotated Sheet Showing Changes



Appl. No. 10/786,687
Amdt. Dated Nov. 3, 2004
Annotated Sheet Showing Changes

